

2001P18436US
60,427-359**REMARKS**

Claims 38-40 stand rejected under 35 USC §103(a) as being obvious in view of Applicant's Admitted Prior Art (AAPA) in view of Balederrama (U.S. Patent No. 5,108,524). Claim 38 recites a method of forming an elastometric seal including the steps of melting a thermal mastic elastometric material to a liquid form and applying the liquid form to a surface of an air induction assembly to form an elastometric seal.

The Examiner argues on page 2 of the Final Office Action that AAPA discloses a "peel and stick" foam gasket material applied to an air induction assembly. The Examiner admits that AAPA does not teach providing a gasket on a desired surface by applying a liquid form of thermal mastic elastomeric material on the surface. The Examiner asserts that Balderrama teaches a method for applying a hot melt material 24 to a cover 16. The Examiner contends it would be obvious to form the gasket of AAPA from a hot melt material in view of Balderrama, and therefore claims 38-40 are obvious. Applicant respectfully disagrees.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Balederrama reference is not analogous art to AAPA or to Applicant's invention.

The Balederrama reference is not in AAPA or Applicant's field and is not reasonably pertinent to the particular problem that the Applicant has solved. AAPA is directed to a "peel and stick" gasket employed with an air induction assembly. Applicant's invention is directed toward a method of forming an elastometric seal for use with an air induction assembly. Balederrama is directed to a trigger actuated dispenser. Thus, Balederrama's field is related to trigger actuated dispensers, while AAPA and Applicant's field concern air induction assemblies. These fields are very different from each other.

Additionally, Balederrama is not reasonably pertinent to the Applicant's particular problem. A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). As discussed above, Balederrama is clearly not within the field of air induction

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assemblies, which is the subject to which Applicant's invention is directed. Further, Balederrama does not logically commend itself to the attention of an inventor seeking to solve problems present in air induction assemblies. This is because Balederrama deals with the problem of preventing gaskets in spray bottles from falling off during shipment (column 3, lines 56 to 66). This is far removed from Applicant's problem of sealing an air induction assembly.

Moreover, even considering, *arguendo*, Balederrama to be analogous art, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. There simply is no teaching, suggestion, or incentive in either of the applied references that would have led one of ordinary skill in the art to modify the air induction assembly of AAPA in the manner proposed by the examiner.

The examiner argues that it would have been obvious to one having ordinary skill in the art to provide the air induction assembly of AAPA "with a foamed hot melt material." This is clearly a use of hindsight reconstruction. It is impermissible to engage in hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby the Applicant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18USPQ2d 1885, 1888 (Fed. Cir. 1991). There simply is no suggestion in the references, or in the prior art as a whole, that suggests the desirability of making the combination. Claims 38-40 are not obvious in view of AAPA and Balderrama, and Applicant respectfully requests that the rejection be withdrawn.

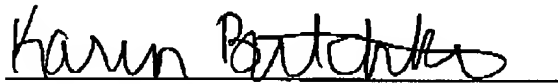
Claims 38-40 also stand rejected under 35 USC §103(a) as being obvious in view of Applicant's Admitted Prior Art (AAPA) in view of Akitomo (U.S. Patent No. 5,391,336). Akitomo does not teach, suggest or disclose a method of forming an elastomeric seal including the step of melting a thermal mastic elastomeric material to a liquid form. Akitomo teaches a method of forming a gasket including the steps of mixing at least two materials, adding a gas, extruding the mixture onto a seal region of a substrate 12, and then curing and foaming the mixture to produce a foam gasket. However, Akitomo does not teach, suggest or disclose the step of melting. Therefore, even if Akitomo is combined with AAPA, the combination does not teach the step of melting a material as claimed by Applicant. Claims 38-40 are not obvious, and Applicant respectfully requests that the rejection be withdrawn.

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Thus, claims 27-29 and 31-40 are in condition for allowance. No additional fees are seen to be required. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment. Therefore, favorable reconsideration and allowance of this application is respectfully requested.

Respectfully Submitted,

CARLSON, GASKEY & OLDS, P.C.

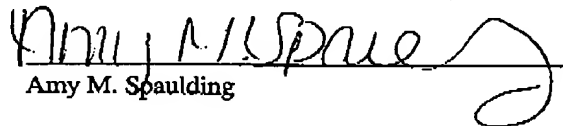


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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, 703-872-9306 on May 24, 2004.



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